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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,709	03/10/2000	Fernando L. Alvarado	43920-032	5984
20277	7590	07/06/2005	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				ALPERT, JAMES M
ART UNIT		PAPER NUMBER		
		3624		

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/522,709	ALVARADO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James Alpert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-9,11,12,14,15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-3,5-9,11-12,14-15 and 17-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

The following communication is in response to Applicant's amendment filed on 29 November 2004.

### ***Status of Claims***

Claims 1,3,5,7,11,&14 are currently amended. Claims 6,9,12,15,&19 are previously presented. Claims 4,10,13,&16 are cancelled. Claims 2,8,17-18, & 20 are as originally submitted. Therefore, Claims 1-3,5-9,11-12,14-15,&17-20 are currently pending.

### ***Summary of Prosecution***

Two non-final office actions have been generated by the Office, the first mailed 05 November 2003 and the second mailed 28 June 2004. Each of these actions offered several 35 U.S.C §112 rejections for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's amendments to the claims are sufficient to overcome these rejections, and the §112 rejections are hereby withdrawn.

To date, no action has presented any rejections based on prior art. MPEP §811 states, in reference to restriction requirements of an applicant's claims,

37 CFR 1.142(a), second sentence states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

The current examiner has reviewed the application, and observed the necessity of restriction to achieve a satisfactory examination of the application. The claims are of such distinctiveness and complexity that further prosecution would result in additional

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time-consuming search and analysis, imposing a serious burden on the Office. As such, the Examiner is obligated to respectfully withdraw the initial indications of allowance of Claims 19-20, and present the following restriction requirement.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. **Claims 1-3, 17 & 19-20**, drawn to a method and medium for managing risk in a market related to a commodity delivered over a network, including a portfolio, classified in class 705, subclass 35.
2. **Claims 5-6 & 18**, drawn to a method and medium for evaluating a portfolio of price risk instruments in a market related to a commodity delivered over a network, classified in class 705, subclass 36R.
3. **Claims 7-9 & 11-12** drawn to methods for hedging a set of underlying positions at a prospective time, and identifying arbitrage opportunities among a plurality of available price risk instruments in a market related to a commodity deliver over a network, classified in class 705, subclass 35/36R.
5. **Claims 14-15**, drawn to a method for identifying arbitrage opportunities among a plurality of available price risk instruments in a market related to a commodity delivered over a network, classified in class 705, subclass 35/36R.

The inventions are distinct, each from the other because Inventions 1-4 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d). In the instant case, Invention 1 has separate utility such as producing a combination of price risk instruments for the market in a proportion such that an effect of the congestion prices for the congestible lines on the locational prices of the commodity is reduced. Invention 2 has separate utility such as evaluating a portfolio based on estimated distribution factors. Invention 3 has separate utility such as

producing a portfolio of price risk instruments for the market based on estimated distribution factors. Invention 4 has separate utility such as producing a portfolio of price risk instruments from among the available price risk instruments in a proportion such that an effect of the congestion prices for the congestible lines on the locational prices of the commodity is eliminated, wherein a number of the price risk instruments is greater than a number of the one or more congestible lines.

Because these inventions are distinct for the reasons given above and the search required for each of the four inventions is distinct from the other three, restriction for examination purposes as indicated is proper.

***Reminders***

No telephone communication was placed regarding this election due to the complex nature of this application and election. See MPEP §812.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is reminded that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that a shortened statutory period for response to this action is set to expire 30 (thirty) days from the mail date of this letter. Failure to respond within

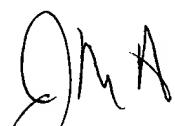
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the period for response will result in abandonment of the application. See 35 U.S.C 133, MPEP §'s 710.02,710.02(b).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James M. Alpert  
27 June 2005

  
JAGDISH N. PATEL  
PRIMARY EXAMINER